

REMARKS

In the Office Action,¹ the Examiner:

- (a) rejected claims 1, 2, 4, 5, 8-11, and 14 under 35 U.S.C. § 102(b) as being anticipated by Okumura (U.S. Patent No. 6,008,871) ("Okumura"); and
- (b) rejected claims 3, 6, 7, 12, and 13 under 35 U.S.C. § 103(a) as being unpatentable over Okumura.

Applicant respectfully traverses the rejections for at least the following reasons.

Rejection of Claims 1, 2, 4, 5, 8-11, and 14 under 35 U.S.C. § 102(b):

Applicant canceled claim 4 in the Amendment filed on June 15, 2009. Therefore the rejection of canceled claim 4 is moot.

Applicant traverses the rejection of claims 1, 2, 5, 8-11, and 14 under 35 U.S.C. § 102(b) as being anticipated by Okumura. Okumura does not anticipate these claims.

In order to properly establish anticipation under 35 U.S.C. § 102, the Federal Circuit has held that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). See also M.P.E.P. § 2131.

¹ The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicant declines to automatically subscribe to any statements in the Office Action.

Okumura fails to teach or suggest each and every element recited in these claims, despite the Examiner's allegations. For example, Okumura fails to teach or suggest at least "a liquid crystal layer..., wherein said liquid crystal layer maintains first and second stable states in the absence of an applied voltage," as recited in independent claim 1 (emphasis added).

The Examiner alleged that "Fig. 4 of Okumura ... discloses the electrode circuit being open (i.e., no voltage) and the liquid crystal being in an ON state and an OFF state" (Office Action, p. 2). The Examiner then concluded that "Okumura fully discloses liquid crystal layer maintain[ing] first and second stable states in the absence of an applied voltage, and one of the first and second stable states is set as the second mode" (Office Action, p. 3). However, this is not correct.

Okumura discloses in Fig. 4 "a liquid crystal [408] in an OFF state" and "a liquid crystal [409] in an ON state" (col. 8, lines 31-33). Fig. 4 of Okumura clearly shows that no voltage is applied to the liquid crystal 408 (see the open switch in Fig. 4) and a voltage is applied to the liquid crystal 409. However, the liquid crystal 408 being in an OFF state without an applied voltage and the liquid crystal 409 being in an ON state with an applied voltage, as taught by Okumura, cannot constitute "maintain[ing] first and second stable states in the absence of an applied voltage," as recited in claim 1 (emphasis added). In fact, neither the portion of Okumura cited by the Examiner nor any other portion of Okumura teaches this element of claim 1.

Further, Okumura discloses that "[t]he liquid crystal layer 105 is made of an STN liquid crystal compound twisted in 210E-270E but if display capacity is small, a TN liquid crystal compound twisted in 90E may be used" (col. 6, lines 49-55). One of ordinary

skill in the art would understand that a liquid crystal layer made of an STN liquid crystal compound or a TN liquid crystal compound may not maintain both ON and OFF states without applying a voltage.

Therefore, Okumura does not teach or suggest "a liquid crystal layer..., wherein said liquid crystal layer maintains first and second stable states in the absence of an applied voltage," as recited in claim 1 (emphasis added).

For at least the reasons discussed above, Okumura does not teach or suggest each and every element recited in claim 1. Therefore, Okumura does not anticipate claim 1. Independent claim 1 is allowable, and dependent claims 2, 5, 8-11, and 14 are also allowable at least by virtue of their dependence on base claim 1. Thus, the rejection of claims 1, 2, 5, 8-11, and 14 under 35 U.S.C. § 102(b) is improper and should be withdrawn.

Rejection of Claims 3, 6, 7, 12, and 13 under 35 U.S.C. § 103(a):

Applicant traverses the rejection of claims 3, 6, 7, 12, and 13 under 35 U.S.C. § 103(a) as being unpatentable over Okumura. No *prima facie* case of obviousness has been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007)*. "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." *M.P.E.P. § 2145*. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant

combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. *M.P.E.P. § 2143.01(III)*, *internal citation omitted*. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *M.P.E.P. § 2141.02(I)*, *internal citations omitted* (emphasis in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966).... The factual inquiries ... [include determining the scope and content of the prior art and] ... [a]scertaining the differences between the claimed invention and the prior art." *M.P.E.P. § 2141(II)*. "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." *M.P.E.P. § 2141(III)*.

Here, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Claims 3, 6, 7, 12, and 13 each depend from base claim 1. As explained above, Okumura does not teach or suggest "a liquid crystal layer..., wherein said liquid crystal layer maintains first and second stable states in the absence of an applied voltage," as recited in claim 1 and included in each claims 3, 6, 7, 12, and 13 (emphasis added).

The Examiner's allegations fail to cure the deficiencies of Okumura. The Examiner alleged that "arranging transmission axis of various optical layers ... is well known in the art," that "the use of liquid crystal molecules with 45 degrees slant is well known," and that "the use of absorbing layers in liquid crystal display ... is well known" (Office Action, p. 5-6). However, whether these allegations are correct or not, neither Okumura, nor the Examiner's allegations, nor any combination thereof, teaches "a liquid crystal layer..., wherein said liquid crystal layer maintains first and second stable states in the absence of an applied voltage," as recited in claim 1 and included in each of claims 3, 6, 7, 12, and 13 (emphasis added).

In view of the shortcomings of the prior art and the errors in analysis of the prior art set forth in the Office Action, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Moreover, there is no motivation for one of ordinary skill in the art to modify the references to achieve the claimed combinations. Thus, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art. Accordingly, no *prima facie* case of obviousness has been established. The 35 U.S.C. § 103(a) rejection of claims 3, 6, 7, 12, and 13 is therefore improper and should be withdrawn.

Conclusion:

In view of the foregoing, Applicant requests reconsideration of the application and withdrawal of the rejection. Pending claims 1-3 and 5-14 are in condition for allowance. Accordingly, Applicant requests a favorable action.

If there are any remaining issues or misunderstandings, Applicant requests the Examiner telephone the undersigned representative to discuss them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 

Yanbin Xu Ph.D
Reg. No. 65,418
(202)408-4000